



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

THEODORE W. HOUSTON

Serial No. 09/346,436 (TI-21004)

Filed July 1, 1999

For: BONDED SOI WITH BURIED INTERCONNECT TO HANDLE OR DEVICE
WAFER

Art Unit 2813

Examiner E. Kielin

Commissioner for Patents
Washington, D. C. 20231

Sir:

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[Signature]

PETITION TO WITHDRAW NOTICE OF ABANDONMENT

Applicant, through his attorney, hereby petitions the Commissioner for Patents to withdraw the holding of abandonment and resume appropriate action in the appeal in this application for reasons stated hereinbelow. No fee is believed to be required since all appropriate actions required by applicant have been made. However, should a fee be required, please charge same to Deposit Account No. 20-0668.

The facts are that a Notice of Appeal and a Brief on Appeal were timely filed in the subject application wherein claims 1 to 4, 7 to 9 and 18 to 24 were appealed and claims 25 and 26 were indicated to be allowable. After receipt of a paper entitled Examiner's Answer, a Reply Brief was filed which dropped the appeal as to claims 1, 3, 7, 8, 18 to 21, 23 and 24, leaving the appeal standing as to claims 2, 4, 9, and 22

(erroneously stating that only claims 9 and 22 were now on appeal) and further arguing the merits of claims 9 and 22. In response thereto, prosecution was reopened and improperly made final since an allegedly new argument was presented by the Examiner and stating that an option for response (two options were provided) was to request reinstatement of the appeal. A Supplemental Appeal Brief was then filed requesting reinstatement of the appeal, stating that the appealed claims were claims 9 and 22 with claims 25 and 26 having been allowed and the appeal as to the remaining claims having been dropped. In response thereto, a Notification of Non-Compliance was received dated September 27, 2002 apparently alleging that there is uncertainty as to which claims are on appeal and stating that no amendment was provided "to indicate that the other claims have been 'cancelled'". In response thereto, a Substitute Supplemental Appeal Brief was filed stating that claims 9 and 22 were appealed and that claims 25 and 26 were indicated to be allowable. The response thereto was a Notice of Abandonment.

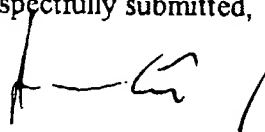
The basis for the holding of abandonment in this case is cavalier and not in accordance with proper patent practice. The fact is that a proper Notice of Appeal was filed as to claims 1 to 4, 7 to 9 and 18 to 24 and that was all that was required to send the appeal to the Board as to all of those claims. When the appeal as to all of these claims (other than claims 2 and 4) was dropped (no longer contested), this amounted to a cancellation of these claims. When it was later stated again that the appeal as to claims 2 and 4 were dropped, this again amounted to a cancellation of these claims. 37 C.F.R. 191 (c) clearly states that "[a]n appeal when taken must be taken from the rejection of all claims under rejection *which the appellant or patent owner proposes to contest*" (italics not in original). Nothing in this section states that all of the rejected claims need be

appealed or that the non-contested claims be cancelled. Clearly, by dropping the appeal as to claims 1 to 4, 7 to 8, 18 to 21, 23 and 24, appellant has chosen not to contest the rejection of those claims. Accordingly, appellant has acted strictly as required by 37 C.F.R. 191. The examiner's allegation that the claims should have been cancelled is not well taken. There is no provision under 37 C.F.R. 191 for filing an amendment and this is apparently the case because any such filing is unnecessary when it involves cancellation of claims as opposed to not contesting the rejection on appeal. The facts are that this application was under appeal and, as such, was not within the jurisdiction of the examiner other than to file the appropriate responses to the briefs by appellants.

Still further, there can be no abandonment since claims have been indicated to be allowable and, even were all of the appealed claims to be dropped, the application should still have been sent to issue with the allowable claims therein.

In view of the above described facts and reasoning, the Notice of Abandonment should be withdrawn and this application should be sent to the Board of Appeals for appropriate decision. Such action is respectfully requested.

Respectfully submitted,



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